



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,237	01/23/2004	Takemori Takayama	KOM-0153/TNO/DIV 3	5466
23353	7590	02/28/2006	EXAMINER	
RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			SAVAGE, JASON L	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/762,237

**Applicant(s)**

TAKAYAMA ET AL.

**Examiner**

Jason L. Savage

**Art Unit**

1775

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 06 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: 13 and 19.  
Claim(s) rejected: 7-12, 14-18.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

**JENNIFER MCNEIL  
PRIMARY EXAMINER**

2/17/06

Continuation of 5. Applicant's reply has overcome the following rejection(s): Rejection to claims 13 and 19, being drawn to contacts containing 12 to 16 wt% Sn and a Cu-Sn compound phase. The claims are now objected as being dependent upon a rejected base claim.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that Takayama'549 fails to disclose, teach or suggest the total amount of intermetallics compounds being equal to 0.1 to 10% by volume. Applicant further states that since the Action conceded that 'Takayama'549 is silent as to the volume% of intermetallic in the contact', that the 102 rejection of the claims is rendered ineffective.

However, since Takayama'549 teaches the same starting materials in similar amounts as that which is claimed in a similar powder metallurgy method to form the sintered copper contact as that taught by Applicant, one would have expected that the intermetallics of the claimed elements would have inherently formed. As such, even though Takayama'549 does not explicitly recite the formation of intermetallics, the claims are still anticipated under 35 USC 102.

Applicant also states that the Examiner has conceded that it is not certain the recited elements of Takayama'549 would form into intermetallics and the disclosure provide no evidence that the elements would form into intermetallics. However, the Examiner merely stated that it is not certain that all of the recited elements would form into intermetallics, i.e. the recited volume % for samples 24 and 25 in table 4 are maximum values whereas the true intermetallic content would likely be somewhat less than the maximum value recited.

Applicant argues that because Takayama'549 fails to disclose, teach or suggest each and every limitation of claim 7, a prima facie anticipation rejection has not be established. However, as was recited above, the limitation not explicitly recited by Takayama'549 is inherently described and as such the prima facie case for anticipation has been established.

Applicant argues the remaining claims are allowable since Takayama'549 does not teach all of the limitations recited in claim 7. However, for the reasons set forth above, claim 7 is still viewed as being anticipated by Takayama'549. As such, Applicant's assertion all of the claims are allowable is not persuasive.